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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/612,635 | 07/02/2003 | Adolf Adrian | | 3661 |
| 7590 | 08/30/2005 | | EXAMINER | |
| Dr. Max Fogiel 44 Maple Court Highland Park, NJ 08904 | | | BURCH, MELODY M | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3683 | |

DATE MAILED: 08/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|-----------------|---------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/612,635 | ADRIAN ET AL. |
| | Examiner | Art Unit |
| | Melody M. Burch | 3683 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 06 July 2005.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 5-11 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 5-11 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 02 May 2005 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission (including the remarks, amendment to the specification, and the amendment to the first two pages of the claims (faxed pages 03/08 and 04/08)) filed on 7/6/05 has been entered.

Specification

2. The abstract of the disclosure is objected to because in lines 2-3 of the abstract Applicant makes reference to a two-cylinder telescoping leg. Applicant eliminated this terminology from the claims since it was unclear to the Examiner whether the telescoping leg was referring to the piston rod. Correction is required. See MPEP § 608.01(b). The term is also found in the title of the application.

3. The disclosure is objected to because of the following informalities: lines 4-5 on pg. 1 and line 25 of pg. 3 of the specification still include a description of a "two-cylinder telescoping leg".

Appropriate correction is required.

Claim Objections

4. Claims 7, 8 and 11 are objected to because of the following informalities: Examiner recommends changing "ring" to --guide-- in line 3 of claim 7 and in line 7 from

the bottom of claim 11 to more accurately define the invention. Appropriate correction is required. Claim 8 is objected to due to its dependency from claim 7.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 5-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re: claims 5 and 11. The phrase “an elastically-tensioned circular ring” first recited in lines 3-4 from the bottom of claim 5 is indefinite. The recitation is unclear since it reads as if the elastically-tensioned circular ring is an element that is separate and distinct from the previously recited lipped seal. A similar issue exists with the added language on pg. 5 line 13- pg. 6 line 3 of the specification. For examining purposes, Examiner has interpreted the claim as reading --a lipped seal comprises an elastically-tensioned circular ring that includes a sealing lip--.

The remaining claims are indefinite due to their dependency from claim 5.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB-2115903 (GB'903) in view of US Patent 4428566 to de Baan et al.

Re: claims 5 and 10. GB'903 shows in figure 1 a sealing and guiding arrangement for passage of a piston rod 3 in a two-cylinder dashpot and for sealing and guiding the piston rod when traveling into and out of the dashpot, comprising: at least one seal 25 for sealing the interior of the dashpot from the outside; at least one radial guide 6 for the piston rod; the two cylinder dashpot having an inner cylinder 1 and an outer cylinder 4, a gas chamber 5 between the outer cylinder and the inner cylinder, a gas channel 28,10,14 extending between the radial guide and the gas chamber, a check valve 19,20 in the gas channel in upstream of the gas chamber as shown and formed as a lipped seal comprising a flow through recess 10,16, a sealing lip 20 on an elastically-tensioned element 19 with a cross-section, the recess being formed in a sealing seat under the element.

GB'903 is silent as to the shape of the elastically tensioned element.

De Baan et al. teach in figure 1 the use of an elastically tensioned element 20 forming a part of a check valve in a gas channel 21 being in the form of a circular ring with substantially circular-shaped cross-section.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the shape of the elastically-tension element of GB'903 to have been circular with a substantially circular shaped cross section, as taught by de Baan et al., in order to provide a means of achieving a particular fluid flow

pattern based on the seal shape as determined by routine experimentation and particular application.

Examiner also notes that in *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) the court held that the configuration of a claimed object was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration was significant.

Re: claim 7. GB'903 shows in figure 1 the limitation of a bushing 7 mounted on an inner surface of the ring indirectly via intervening elements to the same extent as Applicant's invention for radially securing the piston rod.

Re: claim 9. GB'903 shows in figure 1 an auxiliary seal 27 for sealing the sealing and guiding arrangement from the outer cylinder.

Re: claims 6, 8, and 11. GB'903 shows in figure 1 the limitation wherein the sealing lip rests against a surface of a groove shown to the left of portion 20 holding the seal 19,20. GB'903 fails to include the limitation of the surface being conical.

In *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) the court held that the configuration of a claimed object was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration was significant.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the surface of the groove of GB'903 to have been conical or any other appropriate shape as best determined by routine experimentation, in order to provide a certain sealing capacity depending on the particular application.

Please see the rejection of claims 5 and 7 above with regards to the remaining limitations set forth in claim 11.

Response to Arguments

9. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melody M. Burch whose telephone number is 571-272-7114. The examiner can normally be reached on Monday-Friday (6:30 AM-3:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles A. Marmor can be reached on 571-272-7095. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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August 24, 2005

Melody M. Burch
8/24/05